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PATENT
Attorney Docket No.: 016866-002220US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 2-10-05

TOWNSEND and TOWNSEND and CREW LLP

By: Linda Jaffer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

T. William Hutchens et al.

Application No.: 10/626,301

Filed: July 23, 2003

For: RETENTATE
CHROMATOGRAPHY AND PROTEIN
CHIP ARRAYS WITH APPLICATIONS
IN BIOLOGY AND MEDICINE

Customer No.: 20350

Confirmation No. 1861

Examiner: Teresa D. Wessendorf

Technology Center/Art Unit: 1639

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed January 10, 2005, Applicants elect to prosecute the subgenus of anionic adsorbents, such as cationic exchange adsorbents, and the species of carboxylate anionic adsorbents, with traverse.

Applicants respectfully assert that although the Examiner is calling the official action mailed on January 10, 2005 a species election, the Examiner is in fact restricting claim 38. The Examiner asserts authority for the present restriction of claim 38 under 35 U.S.C. § 121 (*see*, page 3, lines 3-5 of the official action mailed on January 10, 2005).

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Claim 38 depends from independent claim 27 and recites the Markush grouping “wherein the adsorbent is a hydrophilic interaction adsorbent, a hydrophobic interaction adsorbent, a metal chelate adsorbent, an anionic adsorbent or a cationic adsorbent.”

Under the controlling legal standard, restriction under 35 U.S.C. § 121 of the subject matter of a single claim is improper and impermissible. Here, because the effective restriction requirement splits a single claim, *i.e.*, claim 38, into multiple groups, *i.e.*, **five** subgenus groups and numerous additional species groups, the effective Restriction Requirement is improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978). As stated in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it. 198 USPQ 328 at 334.

As such, the Examiner’s statement that “a prior art reference anticipating on species would not render obvious the other species” is not proper grounds for issuing the present effective restriction requirement (*see*, page 2-3 of the Restriction Requirement mailed on January 10, 2005). Again, as mentioned above, the courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions.

If the instant effective Restriction Requirement is allowed to stand, Applicants will never be accorded “the basic right of the applicant to claim his invention as he chooses.” *In*

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re Weber, 198 USPQ at 331. In *In re Weber*, the CCPA stated that “[a]s a general proposition, an applicant has a right to have *each* claim examined on the merits” (198 USPQ at 331, emphasis in original). The Court went on to state that:

If . . . a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.” 198 USPQ at 331.

Even if Applicants were to file *five* divisional applications to obtain coverage for the claims in each of the *five* subgenus groups set forth in the present effective Restriction Requirement, they would not have the opportunity to have their broader claim examined. The claims of the *five* divisional applications would be limited to the particular species set forth in each of the *five* respective groups. In effect, the present effective Restriction Requirement is reading into Applicants’ independent claim limitations that are not present in the claim as filed. Claim 38, for example, would never be considered under the current effective Restriction Requirement.

For the foregoing reasons, the effective Restriction Requirement set forth by the Examiner is improper and should be withdrawn.

Accordingly, the Examiner is respectfully requested to withdraw the outstanding restriction requirement.

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PATENT

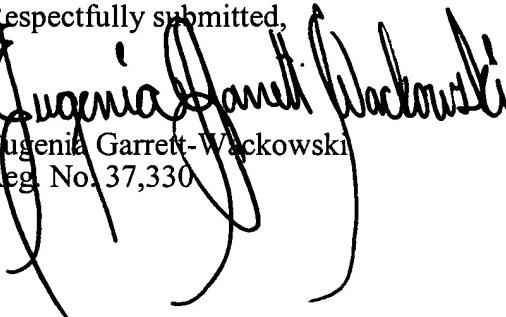
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CONCLUSION

In view of the foregoing, examination at an early date is respectfully requested.
If the Examiner believes a telephone conference would expedite prosecution of this application,
please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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Attachments
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